

REMARKS

Summary

Claims 1-11 were pending. Claims 5-8 were allowed and Claims 1-4 and 9-11 were rejected in the Office action. Claims 2 and 4 have been cancelled without prejudice. Claims 1 and 10 have been amended, and new Claims 12-13 presented. No new matter has been introduced. Claims 1, 3 and 5-13 are pending after entry of this amendment. The Applicants have carefully considered the references and the reasons for rejection advanced by the Examiner and respectfully traverse the rejections in view of the amendments and the discussion presented below. Further, the Applicants respectfully request that the Examiner reconsider and withdraw the finality of the Office action. MPEP 706.07(d) The basis for this request is that the Examiner has, for the first time, made a rejection of Claims 1-4 under 35 U.S.C. §112, first paragraph. As this rejection was neither necessitated by a claim amendment nor based on an information disclosure statement, the Applicants respectfully submit that making the Office Action final is premature. MPEP 706.07(a).

Drawing Objections

The drawing were objected to under 37 CFR 1.83(a) as not showing every feature of the claims; in particular “the claim 1 limitation, ‘whose perimeter has a non-rectangular shape’ must be shown” (Office action, page 2, first paragraph). In view of the discussion presented below, the Applicants respectfully request that the objection be withdrawn.

Claim Rejections

35 U.S.C. §112, first paragraph

Claims 1-4 and 9-11 were rejected under 35 U.S.C. §112, first paragraph, as

“containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the invention. The undescribed subject

matter of the claimed invention is the limitation 'whose perimeter has a non-rectangular shape'" (Id., page 2, last paragraph).

Further, the Examiner suggests that the reasoning in MPEP 2163 II A2(a) results in a determination that "there is insufficient original description of a representative number of species by actual reduction to practice, reduction to drawings...sufficient to show the applicant was in possession of the claimed genus." (Id. Page 3, last paragraph, emphasis added). Both of these rejections are variations on what appears to be an assertion that the Application is defective for want of a written description. The Applicants respectfully traverse this rejection. In particular, the Applicants call attention that the term "non-rectangular" was included in original Claim 1 in the phrase "wherein at least one of the capacitors has an extension that is non-rectangular in shape formed from a plurality of rectangles and the extension projects from one side of another rectangle." Such a description is self supporting, and to the extent that the Examiner may have doubts as to the meaning of this phrase, the Applicants respectfully call attention to the amendment to the specification made in the response to the last office action, where a more elaborate description of such a shape as exemplified by ground capacitors C2 and C7, as illustrated in Fig. 2, was accepted. Moreover, since the original Claim 1 had the language describing a "non-rectangular" shape, and the specification defined "non-rectangular shape", the definition should have been accepted as appropriate for the structure identified in Fig. 2. This was inserted at page 9, line 14. Since the shape is illustrated in Fig. 2, and described in the specification, a person of skill in the art at the time the invention was made would not be in doubt as to the meaning of "non-rectangular shape", and that this is sufficient evidence that the Applicants were in possession of the claimed invention. The Applicants also reiterate the arguments made in response to the previous office action, where it was shown by dictionary definitions that a "rectangle" is a four side figure having exactly four right angles. Any other plane geometrical figure is "non-rectangular". In an effort to expedite the prosecution of this application, the Applicants have amended Claim 1, and introduced dependent Claim 12 and independent Claim 13 to further clarify the subject matter claimed. Any terms not found in the specification are supported by drawing in

Fig. 2, and may be found in conventional dictionaries or treatises on geometry, and are thus inherent.

Claims 1-4 and 9-11 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite in failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. With respect to Claim 1, "there is insufficient basis for the language 'either side' "(Id, page 4, last two paragraphs). The Applicants respectfully submit that the dielectric is described in the specification at, for example, page 12, lines 25-27, as a film laminated between the top and bottom electrodes. As such the film intrinsically has but two sides (e.g., upper and lower, top or bottom), and the phrase "either side" is unambiguous. However, in an effort to expedite the application, Claim 1 has been amended to recite, *inter alia*, "at least one of the capacitors is comprised of a portion of the ground conducting pattern, a dielectric layer above at least the portion of the ground conducting pattern, and an upper plate above at least a portion of the dielectric layer...." The Applicants respectfully submit that this overcomes the rejection.

35 U.S.C. §103(a)

Claims 1, 2, and 10 were rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Haq, Arai and Shanani. Particularly, the Examiner concedes "that Haq does not appear to teach the claimed capacitor shape" (Office action, page 6 last paragraph, first sentence) but asserts that the capacitor shape can be ascertainable by routine experimentation and optimization. Haq does not provide any object for the routine experimentation and optimization suggested by the examiner, and an experiment without an objective cannot achieve a result. Further, the Examiner asserts that "mere dimensional limitations are prima facie obvious absent a disclosure that the limitations are for a particular unobvious purpose, produce an unexpected result, or are otherwise critical" (Id, page 6, last 4 liner). But, to the extent that the cited case law is applicable to this ground for rejection, it applies to dimensions, not shapes. Dimension and shape are ordinary words, and dictionary definitions are suitable for interpretation thereof. Dimensions may be applied to shapes so as to indicate size (e.g. a square 1 meter on a side or a square 10 meters on a side). But something described

as, for example, a square and something described as a pentagon are intrinsically different shapes, except as species of the genus of polygons. One does not mean the other.

Shahani is cited as a reference teaching “at least one of the capacitors is comprised of two parallel plates disposed on either side of a dielectric material and whose perimeter has a non-rectangular shape....” (Shahani, e.g., col. 7, lines 23-32, emphasis added). Claim 1 has been further amended to clearly distinguish the present invention from the reference.

Amended Claim 1 recites, *inter alia*,

a ground conducting pattern formed on and at least partially covering the alumina substrate,

wherein at least one of the capacitors is comprised of a portion of the ground conducting pattern, a dielectric layer above at least the portion of the ground conducting pattern, and an upper plate above at least a portion of the dielectric layer, the upper plate having a perimeter of a non-rectangular shape.

Support for this amendment is evident in Figs. 2 and 3 and related descriptions thereof in the specification. The Applicants respectfully note that the Examiner has depended on the word “non-rectangular” to describe a structure in Shahani and, to the extent that it may be held that this term is not enabling in this application, it cannot be said to be appropriately descriptive in characterizing Shahani. The present amendment, nonetheless, clearly distinguishes the arrangement in Claim 1 from any combination of the references, and Claim 1 is allowable. Claims 3-4 and 9-11 are allowable, without more, as claims dependent on an otherwise allowable independent claim.

Interview Summary

On June 10, 2004 a telephonic interview between Examiner Graybill and Anthony Curtis and Sid Bennett representing the Applicant was conducted. The topic of the interview was the matter of the “non-rectangular” shape. No agreement was reached.

Conclusion

Claims 1 and 10 have been amended; Claims 2 and 4 have been cancelled without prejudice; and new Claims 12 and 13 has been introduced. Claims 1, 3, and 5-13 are now pending.

A Second Supplemental Information Disclosure Statement is submitted of even date with this paper.

For the reasons give above, the Applicants respectfully request that the finality of the Office action be reconsidered and withdrawn. Further, in view of the amendments and for at least the reasons given above, the Applicants respectfully submit that the pending claims are allowable.

The Examiner is respectfully requested to contact the undersigned in the event that a telephone interview would expedite consideration of the application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Anthony P. Curtis', is written over a horizontal line.

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